

Remarks

Claims 1 to 130 have been cancelled without prejudice or disclaimer. Claims 131 to 134 are pending and under consideration.

Rejection in View of Friedhoff

The Examiner rejected claims 131 to 134 under 35 U.S.C. § 102(b) as allegedly being anticipated by Friedhoff et al., *Anal. Biochem.*, 215:9-16 (1993) ("Friedhoff"). See Action at page 3, item 5. Applicant respectfully traverses.

To find anticipation, the Examiner must establish that the prior art document contains all of the elements of the claimed invention. See MPEP § 2131. Each and every claim element must be expressly or inherently described in a single prior art reference. See MPEP § 2131. Here, the Examiner fails to establish that Friedhoff contains every element of the rejected claims.

Specifically, the sections of Friedhoff cited by the Examiner do not show "at least two mobility-modifiers, wherein each different mobility-modifier ***is capable of sequence specific binding to a different addressable support specific portion....***" In fact, the Examiner fails to address that language of claim 131. Specifically, at pages 3 to 4 of the Action, the Examiner appears to omit that language from his analysis. Instead of addressing that claim language, the Examiner states, "Friedhoff teaches a composition comprising...(ii) at least two different mobility modifiers, (see figure 1 and page 12, where the two probes, the Fluorescein labeled and digoxigen labeled probes that bind to the addressable support specific portion represent two different sequence specific mobility modifiers) which further comprises...." See Action at pages 3 to 4. Thus, the

Examiner does not address the claim language “wherein each different mobility-modifier is capable of sequence-specific binding to a different addressable support specific portion....”

In fact, Friedhoff does not show “at least two mobility-modifiers, wherein each different mobility-modifier is capable of sequence specific binding to a different addressable support specific portion....” Friedhoff discusses an Oligonucleotide Ligation Assay designed to detect a single nucleotide change in a template nucleic acid. See Friedhoff at Figure 1 and at page 14, col. 2. Figure 1b of Friedhoff shows two different oligodeoxynucleotides which differ in sequence by a single nucleotide at the 5’ end. See Friedhoff at Figure 1b. Since the oligodeoxynucleotides are substantially the same sequence, both oligodeoxynucleotides will hybridize to the same sequences. See *id.* In fact, in Figure 1 of Friedhoff, both probes hybridize to the same template nucleic acid. See *id.* Friedhoff distinguishes between the two bound oligodeoxynucleotides because ligation of the mismatched oligodeoxynucleotide to an adjacent oligodeoxynucleotide fails. See *id.* Thus, Friedhoff does not show “at least two mobility-modifiers, wherein each different mobility-modifier is capable of sequence specific binding to a different addressable support specific portion....”

Accordingly, for at least that reason, the Examiner has failed to establish that Friedhoff anticipates claim 131. Claims 132 to 134 depend from claim 131. Thus, for the reasons discussed above for claim 131, the Examiner fails to establish that Friedhoff anticipates claims 132 to 134. Because the Examiner fails to establish that Friedhoff anticipates claims 131 to 134 for at least the reasons discussed above, applicant need

not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, applicant in no way acquiesces to those contentions.

Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection in view of Friedhoff.

Conclusion


Applicant respectfully asserts that the application is in condition for allowance and requests issuance of a Notice of Allowance. If the Examiner does not consider the application to be in condition for allowance, applicant requests that he call the undersigned at (650) 849-6658 to set up an interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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